

Appl. Ser. No. 10/018,168

Att. Docket No. 10191/2054

Reply to Office Action of September 11, 2003

REMARKS

Claim 23 is canceled without prejudice, claims 35 and 36 are added, and therefore claims 17 to 22 and 24 to 36 are now pending.

Claim 18 was corrected to correct a minor grammatical error. No new matter was added, and the dependencies of claims 24 to 28 were changed to claim 17 from that of canceled claim 23.

With respect to paragraph three (3) of the Office Action, claims 17 to 20, 23, 31, 32 and 34 were rejected under 35 U.S.C. § 102(b) as anticipated by Hecht et al., U.S. Patent No. 5,918,279.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim limitations be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). In particular, it is respectfully submitted that the reference relied upon would not enable a person having ordinary skill in the art to practice the subject matter of the claims as presented.

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

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As to the "Hecht", it is respectfully submitted that this reference (as characterized in that document) concerns a device for measuring the mass of a flowing medium in which flow cross sections of the flow opening are adapted to the oncoming flow to "bring about a flow with substantially even velocity distribution downstream of a grid." (See "Hecht", Abstract). It is also respectfully not understood how the text sections cited in the Office Action in any way support the assertion that the grid 21 is the same as the mechanical-acoustic prevention element as recited in the context of claim 17, and as understood in the context of the specification. The Substitute Specification states at page 2 that the device of the claimed subject matter has the advantage that acoustic disturbances are avoided. The specification of the present application also states at page 2 that the result of acoustic disturbance avoidance or suppression is provided by the suppression (that is, the mechanical-acoustic prevention) elements which are used to at least reduce the formation of ring-shaped eddies.

While the rejections may not be agreed with, to facilitate matters and to better clarify the claimed subject matter, the features of canceled claim 23 has been included in claim 17. Accordingly, the "Hecht" reference does not identically describe (or even suggest) all of the features of claim 17 as presented, including the use of mechanical-acoustic prevention elements, as recited in the context of claim 17 and as understood in view of the specification of the present application. In particular, claim 17 as presented provides that the medium flows around the radial elevations 79 and that these act as mechanical-acoustic prevention elements.

In contrast, in the "Hecht" reference, the ribs 38, around which no medium flows, are used to engage grooves 37 of the grid ring 21 to provide an orientation of the flow openings 40, as referred to at lines 56 to 67 of column 3 of the "Hecht" reference. In "Hecht", a narrowing of line 5 is effected by the grid ring 21, which has no radial elevations to prevent or reduce any acoustic interference produced by the grid ring 21.

Claim 17 as presented is therefore allowable, as are its dependent claims 18 to 34.

With respect to paragraph four (4) of the Office Action, claims 21, 22, 29, 30 and 33 were rejected under 35 U.S.C. § 103(a) as obvious over the "Hecht" reference in view of Tank et al., U.S. Patent No. 6,272,920.

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First, claims 21, 22, 29, 30 and 33 depend from claim 17 and are therefore allowable at least for essentially the same reasons as claim 17, as explained above, since the secondary reference does not cure the critical deficiencies of the primary reference.

Second, the secondary reference is removable under 35 U.S.C. § 103(c). In particular, the “Tank” reference is only a reference under 35 U.S.C. § 102(e). In this regard, Applicants state that the subject matter of the “Tank” reference and the claimed invention of the present application “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”, with Robert Bosch GmbH being the “same person”. It is therefore respectfully submitted that the reference must be removed under 35 U.S.C. § 103(c) in view of the foregoing statement, and it is respectfully requested that the obviousness rejections be withdrawn. (See 1241 O.G. 96 (December 26, 2000) concerning revised guidelines for removing a reference under 35 U.S.C. § 103(c), which provides for the attorney of the Applicants to make the “commonly owned” statement).

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998). The prior art simply does not address the “acoustic disturbance” problems met by the subject matter of any of the rejected claims.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action’s assertions that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

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Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is respectfully submitted that the Office Action reflects hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner*

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claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the references relied upon. As referred to above, any review of the references, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the rejected claims.

More recent still, in the case of *In re Lee*, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor

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required by precedent is both legal error and arbitrary agency action.

[The] "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation.

[The] Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

Accordingly, claims 21, 22, 29, 30 and 33 are allowable for all of the above reasons.

New claims 35 and 36 do not add any new matter and are supported in the specification. New claims 35 and 36 depend from allowable claim 17, and are therefore allowable for the same reasons as claim 17.

It is therefore respectfully submitted that claims 17 to 22 and 24 to 36 are allowable.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 17 to 22 and 24 to 36 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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Dated: 10/17/2003

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